

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

HM

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

09/230,111 05/17/99 SATO

T 48962-A-PCT-

HM12/0522

EXAMINER

JOHN P WHITE
COOPER & DUNHAM
1185 AVENUE OF THE AMERICAS
NEW YORK NY 10036

HOLLERAN, A

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

05/22/01

19

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 09/230,111	Applicant(s) Sato et al.
	Examiner Anne Holleran	Art Unit 1642
<i>-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --</i>		
Period for Reply		
A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>1</u> MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.		
<ul style="list-style-type: none"> - Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication. - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely. - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication. - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). - Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b). 		
Status		
1) <input checked="" type="checkbox"/> Responsive to communication(s) filed on <u>Feb 20, 2001</u>		
2a) <input type="checkbox"/> This action is FINAL. 2b) <input checked="" type="checkbox"/> This action is non-final.		
3) <input type="checkbox"/> Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under <i>Ex parte Quayle</i> , 1935 C.D. 11; 453 O.G. 213.		
Disposition of Claims		
4) <input checked="" type="checkbox"/> Claim(s) <u>27-76</u> is/are pending in the application.		
4a) Of the above, claim(s) _____ is/are withdrawn from consideration.		
5) <input type="checkbox"/> Claim(s) _____ is/are allowed.		
6) <input type="checkbox"/> Claim(s) _____ is/are rejected.		
7) <input type="checkbox"/> Claim(s) _____ is/are objected to.		
8) <input checked="" type="checkbox"/> Claims <u>27-76</u> are subject to restriction and/or election requirement.		
Application Papers		
9) <input type="checkbox"/> The specification is objected to by the Examiner.		
10) <input type="checkbox"/> The drawing(s) filed on _____ is/are objected to by the Examiner.		
11) <input type="checkbox"/> The proposed drawing correction filed on _____ is: a) <input type="checkbox"/> approved b) <input type="checkbox"/> disapproved.		
12) <input type="checkbox"/> The oath or declaration is objected to by the Examiner.		
Priority under 35 U.S.C. § 119		
13) <input type="checkbox"/> Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).		
a) <input type="checkbox"/> All b) <input type="checkbox"/> Some* c) <input type="checkbox"/> None of: 1. <input type="checkbox"/> Certified copies of the priority documents have been received. 2. <input type="checkbox"/> Certified copies of the priority documents have been received in Application No. _____. 3. <input type="checkbox"/> Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).		
*See the attached detailed Office action for a list of the certified copies not received.		
14) <input type="checkbox"/> Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).		
Attachment(s)		
15) <input type="checkbox"/> Notice of References Cited (PTO-892)		
16) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)		
17) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____		
18) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____		
19) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)		
20) <input type="checkbox"/> Other: _____		

DETAILED ACTION

1. Applicant's election with traverse of group II, claims 52-76, in Paper No. 16, filed Dec. 12, 2000, is acknowledged. Applicant's arguments are found persuasive with regard to restriction between group I and group II and the restriction between the two groups is removed. However, an election of species is required as follows:

Election/Restrictions

2. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

- a) methods of screening compounds in which the signal transducing protein is a cell surface receptor,
- b) methods of screening compounds in which the signal transducing protein is a signal transducer protein,
- c) methods of screening compounds in which the signal transducing protein is a tumor suppressor protein

3. Applicant is required, in reply to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The reply must also identify the claims readable on the elected species, including any claims subsequently added. An argument

that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

4. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

The claims are deemed to correspond to the species listed above in the following manner:

species a: 27-37, 40-46, 50-62, 65-71, 75, 76

species b: 27-36, 38, 47, 50, 52-61, 63, 72, 75, 76

species c: 27-36, 39, 48-50, 52-61; 64, 73-76

The following claim(s) are generic: 27-36, 50, 52-61, 75, 76

5. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: each of the species relates to separate and distinct classes of protein product which would be expected to interact with separate and distinct classes of cytoplasmic proteins. There is no special technical feature which relates separate classes of protein products with each other and therefore methods for screening for compounds which inhibit the formation of complexes between each of the separate classes of protein product and a

cytoplasmic protein would be separate and distinct methods. Furthermore, the interaction between the proteins with a GLGF domain (PDZ domain) and proteins with an SXV domain is known in the art as evidenced by the teachings of Kornau et al. (Kornau, H.-C. et al. Science, 269: 1737-1740, 1995).

Any inquiry concerning this communication or earlier communications from the Office should be directed to Anne Holleran, Ph.D. whose telephone number is (703) 308-8892. Examiner Holleran can normally be reached Monday through Friday, 9:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, Ph.D. can be reached at (703) 308-3995.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at telephone number (703) 308-0196.

AH
Anne L. Holleran
Patent Examiner
May 19, 2001

AC
ANTHONY C. CAPUTA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600